UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/741,265	10/30/1996	HARDISH SINGH	11611.4US01	1018

7590 08/27/2003

CRAWFORD PLLC
1270 NOTHLAND DR.
SUITE 390
MENDOTA HIEGHT'S, MN 55120

EXAMINER	
YAO, KWANG BIN	

ART UNIT	PAPER NUMBER
2667	28

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	08/741,265	SINGH ET AL.	
	Examiner	Art Unit	
	Kwang B. Yao	2667	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 June 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12 and 16-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12 and 16-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1, 4 and 16-23 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by White et al. (US 6,069,890).

Regarding claims 1, 16 and 17, White et al. discloses a system for providing telephone type services comprising the following features: in Fig. 2, telephone 56; central office 50 coupled to telephone 56, and configured and arranged to receive audio information designating the number of telephone 58; the central office 50 including a first output to PSTN via link 54, and a second output to Internet 84 via link 76, Internet module 72 and link 86; central office 50 for analyzing the dialing digits from telephone 56, and for determining if there is a prefix *82 in the dialing digits, and for establishing a regular telephone call via PSTN 57 if there isn't any prefix, and for establishing an Internet call via Internet 84 if there is a prefix *82 in the dialing digits and communicating the audio information in accordance with the TCP/IP protocols. See column 5, line 64 to column 6, line 5.

Regarding claim 4, White et al. discloses the following features: as depicted in Fig. 5, step 140, gateway router for assembling the audio information signals into TCP/IP packet.

Regarding claims 18 and 21, White et al. discloses the following features: the system determines whether the call is to be routed to the PSTN or Internet by comparing the dialing digits to the phone number/IP address information in the Internet address database 112 in Fig. 4; this process is without the intervention of either the calling party or the called party, and is without any further information from calling party besides the dialing digits. See column 5, lines 52-55; column 9, lines 11-29.

Regarding claims 19 and 22, White et al. discloses the following features: the system determines whether the call is to be routed to the PSTN or Internet by detecting *82 received as part of dialing digits, the *82 can be referred as the number of an Internet module 72 in Fig. 2 because the system will route the call to Internet if there is the detected code of *82; this process is without the intervention of either the calling party or the called party, and is without any further information from calling party besides the dialing digits. See column 5, lines 52-55; column 6, lines 43-56.

Regarding claims 20 and 23, White et al. discloses the following features: the system determines whether the call is to be routed to the PSTN or Internet by comparing the dialing digits to a telephone number stored in the Internet address database 112 in Fig. 4; this process is without the intervention of either the calling party or the called party, and is without any further information from calling party besides the dialing digits. See column 5, lines 52-55; column 9, lines 11-29, step 136 of Fig. 5.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 2, 3, 5, 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US 6,069,890) in view of Kuthyar et al. (US 5,909,431), Shinohara et al. (US 5,351,237).

White et al. discloses the claimed limitations set forth. White et al. does not disclose the features of: RAS standard gatekeeper protocol, Q.931 standard Internet call protocol, H.245 standard end-to-end protocol; RTP standard protocol.

Kuthyar et al. discloses a real time multimedia service in a hybrid network comprising the following the features: system control entity 106 in Fig. 3 using RAS standard gatekeeper protocol; entity H.225.0/RTP 108 using standard real time transfer protocol. See column 4, line 67 to column 5, line 2. Kuthyar et al. discloses the features of using H.245 protocol, see column 5, line 64-67.

Shinohara et al. discloses a network system comprising the following features: DCH call control section 333 in Fig. 2 using Q.931 standard call control protocol. See column 4, lines 39-41.

Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to modify the system of White et al., by using the standard protocols, as taught by Kuthyar et al., and Shinohara et al., in order to take advantage of well developed and globally recognized standard protocols.

5. Claims 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US 6,069,890) in view of Schulzrinne et al. (RFC 1889).

White et al. discloses the claimed limitations set forth. White et al. does not disclose the features of: a standard quality of service protocol for gathering QoS statistics regarding packetized information; monitoring QoS statistics to adaptively control a rate which audio information is transferred. Schulzrinne et al. discloses the following features in RFC 1889: a standard quality of service protocol for gathering QoS statistics regarding packetized information; monitoring QoS statistics to adaptively control a rate which audio information is transferred. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to modify the system of White et al, by using the features, as taught by Schulzrinne et al., in order to reduce the possibility of network congestion.

6. Claims 8, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US 6,069,890) in view of Kuthyar et al. (US 5,909,431), and Shinohara et al. (US 5,351,237) as applied to claims 1, 4 and 5 above, and further in view of Schulzrinne et al. (RFC 1889).

White et al., Kuthyar et al., Shinohara et al. disclose the claimed limitations set forth. However, they do not disclose the features of: a standard quality of service protocol for gathering QoS statistics regarding packetized information; standard quality of service protocol using standard real time transfer control protocol RTCP; monitoring RTCP information to adaptively control a rate which audio information is transferred. Schulzrinne et al. discloses the following features in RFC 1889: a standard quality of service protocol for gathering QoS statistics regarding packetized information; standard quality of service protocol using standard real time transfer control protocol RTCP; monitoring RTCP information to adaptively control a rate which audio information is transferred. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to modify the combined system of White et al., Kuthyar et al., and Shinohara et al., by using the features, as taught by Schulzrinne et al., in order to reduce the possibility of network congestion.

Response to Arguments

7. Applicant's arguments filed 6/13/03 have been fully considered but they are not persuasive.

On pages 2-3, Applicant argues that White et al. (US 6,069,890) fails to include the limitations of requiring that the audio information being analyzed for the determination also designate a telephonic communication addressee; in contrast, White et al. teaches using a special prefix, such as 82, that is neither used to designate a telephonic communication addressee, nor is send down the selected path to establish the communication. Examiner respectfully disagrees with these arguments. First of all, it appears that Applicant's arguments are different than the

features disclosed by the present application. On lines 4-12 of page 11 at the present application, it discloses that a DTMF code, such as *7, is being analyzed for the determination and also designation of a telephonic communication addressee. On the other hand, White et al. discloses the exact same technique of using a DTMD code (*82 plus the directory number of the called party) to designate a telephonic communication addresses; and it is sent down to the central office switching system via a selected path to establish communication. Therefore, it is respectfully maintained that the reference of White et al. does anticipate the claimed invention.

On last paragraph of page 3 to page 4, Applicant argues that the Office Action fails to present any evidence of motivation or rational for combining the cited reference. Examiner respectfully disagrees with this argument. It is recognized that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivations for combining the cited references are in the knowledge generally available to one of the ordinary skill in the art.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwang B. Yao whose telephone number is 703-308-7583. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi H Pham can be reached on 703-305-4378. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

KWANG BIN YAO
PRIMARY EXAMINER

Kwang B. Yao
August 25, 2003